

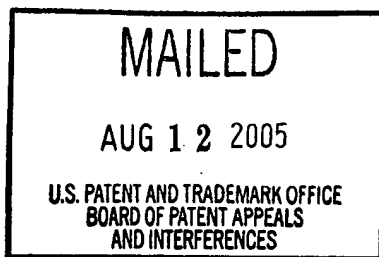
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte BRUCE HENRY GARVIE

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Appeal No. 2005-1619  
Application No. 09/584,375

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ON BRIEF

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5 and 12 to 20, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a composite cleat for sports shoes. More particularly, the appellant's invention relates to an insert for a cleat, a two component cleat for an article of footwear and a method of manufacturing the cleat (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Brady	2,222,650	Nov. 26, 1940
MacNeill	5,996,260	Dec. 7, 1999
Aotani	EP 0 342 232 A1	Nov. 23, 1989

Claims 1 to 5 and 12 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aotani in view of Brady and MacNeill.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed July 28, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed May 10, 2004) for the appellant's arguments thereagainst.

OPINION

In the brief (p. 5), the appellant stated that: Claims 1, 2, 3 and 12-20 stand or fall together. Claims 4 and 5 stand or fall together.

In accordance with the appellant's grouping of claims and arguments provided, we need to review only the rejections of claims 1 and 4 to decide the appeal on the rejection under 35 U.S.C. § 103 set forth above.

Claims 1 and 4 read as follows:

1. A cleat for an article of footwear consisting entirely of plastic, the cleat comprising:
  - an insert and a plastic traction member, the insert and traction member constituting separate and distinct elements formed at distinct times in the manufacture process;
  - the insert is from a synthetic plastic material, wherein the insert has a stem portion with engagement means for releasable engagement with a complementary formation defined on an undersole of the article of footwear; and
  - the plastic traction member is secured to the insert during a molding process, and encases the insert with the exception of the engagement means, thereby holding the traction member captive on the insert; wherein the insert is made entirely from a synthetic plastic material having a greater hardness than the traction member.
4. The cleat according to claim 2, wherein the insert includes a raised spike opposite the first end of the stem portion, the raised spike being aligned with a traction member spike to cooperate therewith and function as a visual wear indicator for the cleat.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is sufficient to establish a prima facie case of obviousness with respect to claim 1 but not for claim 4. Accordingly, we will sustain the examiner's rejection of claim 1 and claims 2, 3 and 12 to 20 which fall therewith under 35 U.S.C. § 103. We will not sustain the examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Aotani's invention relates to multipurpose shoes which can be used for a plurality of purposes, and each of which consists of a combination of a shoe body provided in the lower surfaces thereof with a plurality of spike-setting bores, and a spike set composed of at least two groups of different types of spikes, each of the spikes which constitute the spike groups being fixed exchangeably in the spike-setting bores. Figures 4, 5, 6, 8 and 9 show various two-piece spikes (41, 51, 61, 81, 91). The first piece is made from a metal or a plastic. The first piece has a disk-shaped portion (41a, 51a, 61a, 81a, 91a) and a screw portion (41c, 51c, 61c, 81c, 91c). The second piece (41b, 51b, 61b, 81b, 91b) is made from an elastic material such as rubber. The second piece can be formed with ridges and valleys as shown in Figures 5, 6 and 8. As shown in Figures 4, 5 and 9, the second piece encases the first piece on one side of the disk-shaped portion while permitting the screw portion to extend from the other side of the disk-shaped portion. As shown in Figures 6 and 8, the second piece does not encase the first piece on the side of the disk-shaped portion opposite the screw portion due to a projection (61e, 81e).

MacNeill's invention relates to the mounting of traction gear on the bottom of footwear, in particular, athletic footwear. Figures 1 and 2 illustrate a dual density cleat. Around the outer circumference are four projections 12 which protrude out from a foundation 14. The top of the cleat is substantially flat so as to form a skirt 22 which

contacts the sole of the athletic shoe when the cleat is installed. A preferred embodiment further includes an internal metal support structure 24, a portion of which may project above the skirt 22 to form attachment means for connecting the cleat 10 to a shoe. The internal metal support structure 24 is shown as having threads 26 adapted to engage a threaded receptacle in the sole of the shoe. When the cleat 10 is attached to an athletic shoe descending towards the turf, the projections 12 are the first part of the cleat 10 to engage the ground. In order to cushion the impact, the projections 12 are covered with an outer layer 20 of relatively soft deformable material, such as natural rubber, thermoplastic rubber, soft polyvinyl-chloride, soft poly urethane, or soft plastic. The outer layer 20 of soft deformable material overlays the projections 12 and is supported by stronger and stiffer material of the base 21, e.g., nylon, acetal, hard polyurethane, or hard plastic. The soft outer layer 20 also provides improved traction or slip resistance in environments other than turf penetrating athletic surfaces such as on smooth or slick surfaces, e.g., tile floors.

Brady's invention relates to pegs or cleats such as worn on the shoes of athletes to improve traction. As shown in Figure 10, cleats includes a pegs formed of metal, having frustrum shaped ends 14, enlarged flanges 15 and screw-threaded studs 16. Each peg is encased in a sheath of rubber, the portion 19 of the rubber being surface bonded to the flange 15, and the portion 20 which overlies the frustrum portion of the

peg being unsecured . The portion 20 normally prevents contact of the peg with objects and yields to permit the peg to penetrate the ground. Figure 15 illustrates a peg 31 completely enclosed in a sheath of rubber. The rubber may deform and stretch to enable the peg to penetrate the ground.

**Claim 1**

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Aotani and claim 1, it is our opinion that the differences are as follows: (1) the traction member being a plastic traction member; and (2) the insert being made from a plastic material having a greater hardness than the traction member.

With regard to these differences, in applying the above-noted test for obviousness, we conclude that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified spike 51 of

Aotani by (1) making the first piece (disk-shaped portion 51a and screw portion 51c) from a hard plastic and (2) making the second piece (51b) from a soft plastic as suggested and taught by MacNeill.<sup>1</sup> The motivation for this modification to Aotani comes from MacNeill's teachings that a soft plastic outer layer over a hard plastic inner layer cushions the impact while also providing improved traction or slip resistance in environments other than turf penetrating athletic surfaces such as on smooth or slick surfaces, e.g., tile floors. In addition, MacNeill teaches that either rubber or soft plastic can be used as alternative outer layers in a cleat. We note that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

The appellant argues that the applied prior art does not suggest the subject matter of claim 1. We do not agree. As pointed out above, the teachings of Aotani and MacNeill are suggestive of the subject matter of claim 1.

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<sup>1</sup> Thus, we regard the examiner's application of the teachings of Brady to be mere surplusage with regard to the obviousness rejection of claim 1.



The appellant also argues that the recitation of claim 1 that "the plastic traction member is secured to the insert during a molding process" is not met. The appellant has not pointed out any structural difference that would differentiate the cleat of claim 1 from Aotani's spike 51 when modified as suggested by MacNeill. In addition, the product-by-process limitation set forth in claim 1 (i.e., "the plastic traction member is secured to the insert during a molding process") does not affect the product itself (i.e., the claimed cleat) and therefore cannot impart patentability to the product. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.). See also Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834, 8443-47, 23 USPQ2d 1481, 1488-91 (Fed. Cir. 1992). Once the appellant has been provided with a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the appellant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. See In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983). The appellant has not come forward with any evidence to

satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

#### **Claims 2, 3 and 12 to 20**

The appellant has grouped claims 1 to 3 and 12 to 20 as standing or falling together. Thereby, claims 2, 3 and 12 to 20 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2, 3 and 12 to 20 under 35 U.S.C. § 103 is also affirmed.

#### **Claims 4 and 5**

We will not sustain the rejection of claims 4 and 5 under 35 U.S.C. § 103.

The appellant argues (brief, pp. 7-13) that the applied prior art does not suggest the subject matter of claim 4. We agree. In our view, the teachings of Brady and MacNeill are not sufficient to have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Aotani so as to arrive at the subject matter of claim 4. In that regard, it is our opinion that if an artisan were to cover

Aotani's projection (61e or 81e) as suggested by Figure 15 of Brady, the artisan would have used rubber as taught by Brady and Aotani. In our view, the only suggestion for modifying Aotani to arrive at the subject matter of claim 4 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claim 4, and claim 5 dependent thereon, under 35 U.S.C. § 103 is reversed.

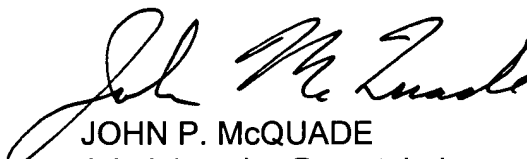
#### CONCLUSION


To summarize, the decision of the examiner to reject claims 1 to 5 and 12 to 20 under 35 U.S.C. § 103 is affirmed with respect to claims 1 to 3 and 12 to 20 and reversed with respect to claims 4 and 5.

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

  
CHARLES E. FRANKFORT  
Administrative Patent Judge

  
JOHN P. McQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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